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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,914	11/30/2001	Richard P. Sinn	21756-013600	4276

51206 7590 02/16/2007 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834	EXAMINER
	LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
2131	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 December 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,6-11,13,20,21,23,25-27 and 42-49* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6-11,13,20,21,23,25-27 and 42-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The amendment filed 04 December 2006 has been noted and made of record.

2.   Claims 1, 2, 4, 6-11, 13, 20, 21, 23, 25-27, and 42-49 have been presented for

examination.

to Arguments

3.   Applicant's arguments, see page 8, filed 04 December 2006 with respect to the 35 U.S.C.

112 rejection of claims 48 and 49 have been fully considered and are persuasive. The rejection

of claims 48 and 49 35 U.S.C. 112 under has been withdrawn.

4.   Applicant's arguments regarding the prior art rejections filed 04 December 2006 have

been fully considered but they are not persuasive.

5.   In response to the Applicant's argument that U.S. 2002/0053023 to Patterson et al.,

hereinafter Patterson, does not qualify as prior art, the Examiner disagrees. The Applicant's

arguments prompted the Examiner to further review the Applicant's priority claim to provisional

application 60/258,087, filed on 22 December 2000. Under 35 U.S.C. 119 (a) or (e), the claims

in a U.S. application are entitled to the benefit of a foreign priority date or filing date of a

provisional application if the corresponding foreign application or provisional application

supports the claims in the manner required by 35 U.S.C. 112, first paragraph. See MPEP §

2163.03 (III). See also *In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir.

1993); *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973); *In re Gosteli*, 872 F.2d

1009, 10 USPQ2d 1614 (Fed. Cir. 1989). Provisional application 60/258,087 fails to provide a

written description for the invention disclosed in application 09/998,914.

6.   A written description requirement issue generally involves the question of whether the

subject matter of a claim is supported by the disclosure of an application as filed. See MPEP §

2163. Provisional application 60/258,087 makes mention of certificates (i.e. X.509 or certificate)

on pages 9, 11, 12, 13, 18 and page 26, but makes no mention of checking the status of

certificates. Furthermore, the certificates discussed in provisional application 60/258,087 are for

granting access to specific roles based on the certificate. Provisional application 60/258,087 fails

to provide a written description for the invention of application 09/998,814 and therefore priority

to provisional application 60/258,087 is denied.

7.   Since a new ground of rejection has not been presented in this Office Action and only the

priority has been denied, the finality of this Office Action is proper.

8.   In response to the Applicant's argument that the cited prior art does not teach determining

whether to check a status for a certificate at a check time, and, in response to determining to

check the status for the certificate at a check time, determining whether to check the status for

the certificate in real time, the Examiner disagrees. Patterson discloses determining whether to

check the status of a certificate at certain intervals as disclosed in at least paragraphs 0061

through 0063.

9.   Therefore, Patterson discloses determining whether to check a status for a certificate at a

check time, and, in response to determining to check the status for the certificate at a check time,

determining whether to check the status for the certificate in real time in at least paragraphs 0061

through 0063 as cited below.

10.   With respect to the Applicant's allegation that Patterson does not disclose determining

whether to check the status for a certificate at a check time and determining whether to check the

certificate in real-time, the Examiner kindly directs the Applicant's attention to MPEP § 2131, in

particular the discussion of *ipsissimis verbis*. *Ipsissimis verbis* states that the elements of the

invention must be arranged as required by the claim regardless of the identity of terminology. In

other words, the fact that Patterson does not use the same terminology as the Applicant, yet

teaches the elements of the claim language is not enough to distinguish the instant application

over the prior art.

11.   See further rejections that follow.

Priority

12.   Under 35 U.S.C. 119 (a) or (e), the claims in a U.S. application are entitled to the benefit

of a foreign priority date or filing date of a provisional application if the corresponding foreign

application or provisional application supports the claims in the manner required by 35 U.S.C.

112, first paragraph. See MPEP § 2163.03 (III). See also *In re Ziegler*, 992 F.2d 1197, 1200, 26

USPQ2d 1600, 1603 (Fed. Cir. 1993); *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA

1973); *In re Gosteli*, 872 F.2d 1009, 10 USPQ2d 1614 (Fed. Cir. 1989). Provisional application

60/258,087 fails to provide a written description for the invention disclosed in application

09/998,914.

13.   A written description requirement issue generally involves the question of whether the

subject matter of a claim is supported by the disclosure of an application as filed. See MPEP §

2163. Provisional application 60/258,087 makes mention of certificates (i.e. X.509 or certificate)

on pages 9, 11, 12, 13, 18 and page 26, but makes no mention of checking the status of

certificates. Furthermore, the certificates discussed in provisional application 60/258,087 are for

granting access to specific roles based on the certificate. Provisional application 60/258,087 fails

to provide a written description for the invention of application 09/998,814 and therefore priority

to provisional application 60/258,087 is denied.

Claim Rejections - 35 USC § 102

14.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

15.   Claims 1, 2, 4, 8, 9, 11, 13, 20, 21, 23, 25-27, 42, 43, 45, 46, 48, and 49 are rejected

under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No.

2002/0053023 to Patterson et al., hereinafter Patterson.

16.   As per claims 1 and 20, Patterson discloses a method comprising the steps of:

retrieving real time status for a certificate (Figure 7 [step S6], page 4, paragraph [0058],

i.e. "The public repository **64** will in due course, return an identification of the validity of the

certificate using, for example, a protocol such as the Online Certificate Status Protocol");

storing said real time status (Figure 7 [step S7], page 4, paragraph [0059], i.e. "on receipt

of the certificate validity information, this is stored in the user cache **86** for the intended

recipient"); and

storing validation information for said certificate, wherein said validation information

includes an identifier of a time said real time status was retrieved and a validation interval for

said real time status (Figures 5-7 [step S7], page 3, paragraphs [0051]-[0052], page 4, paragraph

[0059]-[0061], i.e. "the user cache **86** includes, for certificates that have already been checked,

the sender identity associated with the certificate, the certificate as extracted from a previously

received message and as verified with the public repository, the result of verifying the validation

with the repository, and the time and date of the validation of the certificate. The result of such a

check of certificate status will typically be one of 'valid,' 'revoked,' or 'unknown.'" "on receipt

of the certificate validity information, this is stored in the user cache **86** for the intended

recipient")

receiving a request to export said certificate (Figures 7 [steps S1, S2], 8a [step S10], 8b

[steps s11, s12], pages 3-4, paragraphs [0055]-[0060]);

determining whether to check a status for said certificate at a check time (Figure 7 [step

S6], page 4, paragraphs [0058], [0061], [0063], i.e. "The public repository **64** will in due course,

return an identification of the validity of the certificate using, for example, a protocol such as the

Online Certificate Status Protocol");

in response to determining to check the status for said certificate at a check time,

determining whether to check status for said certificate in real time (Figure 7 [step S7], page 4,

paragraph [0058]).

17.   Regarding claims 2 and 21, Patterson teaches wherein said step (c) includes the step of:

setting said validation interval to zero when said real time status retrieved is not valid

(Figures 5-7 [step S7], page 3, paragraphs [0051]-[0052], page 4, paragraph [0059], i.e. "The

result of such a check of certificate status will typically be one of 'valid,' 'revoked,' or

'unknown.'").

18.   Regarding claims 4 and 23, Patterson discloses the steps of determining whether said

check time falls within a time period, wherein said time period begins at said time said real time

status was retrieved and extends for said validation interval (page 4, paragraph [0062], i.e. checking the expiry time).

19. Concerning claims 6 and 25, Patterson teaches wherein exporting said certificate, if said check time falls within said time period (page 4, paragraph [0062], i.e. checking the expiry time).

20. Concerning claim 8, Patterson teaches retrieving a new real time status for said certificate, in response to determining to check status for said certificate in real time (page 4, paragraph [0063]).

21. Concerning claim 9, Patterson teaches exporting said certificate, if said new real time status indicates said certificate is valid (Figures 7 [steps S8, S9], 8a [step S10], 8b [steps s11, s12], page 4, paragraphs [0060], [0064]-[0067]).

22. Regarding claims 11 and 27, Patterson discloses receiving a request to display information from said certificate (figure 7 [steps S1, S2, S3], page 4, paragraph [0064]);

retrieving a status for said certificate (page 4, paragraph [0058]); and

displaying said information from said certificate and said status (Figures 8a, 11, page 4, paragraphs [0064]-[0067]).

23. With regards to claim 13, Patterson discloses wherein said step (j) includes the steps of:

determining whether to check status for said certificate in real time (page 4, paragraph

[0058]);

retrieving said real time status for said certificate to serve as said status, if it is

determined to check status in real time (page 4, paragraph [0058]); and

retrieving a new real time status to serve as said status, if it is determined not to check

status in real time (pages 3-4, paragraph [0057]).

24.   As per claim 42, Patterson discloses a method comprising:

retrieving a real time status for a certificate (Figure 7 [Step S6], page 4, paragraph   .

[0058]);

storing the real time status (Figure 7 [step S7], page 4, paragraph [0059]);

storing validation information for the certificate, wherein the validation information

includes an identifier of a time the real time status was retrieved and a validation interval for the

real time status (Figures 5-7 [step S7], page 3, paragraphs [0051]-[0053], [0058]-[0061]);

receiving a request to export the certificate (Figure 7 [steps S1, S2], 8a [step S10], 8b

[steps s11, s12], pages 3-4, paragraphs [0055]-[0060]);

determining whether to check a status for the certificate at a check time (Figure 7 [step

S4], page 4, paragraphs [0058]-[0061]);

in response to determining to not check the status for the certificate, exporting the

certificate (Figure 7 [steps S1, S2], 8a [step S10], 8b [steps s11, s12], pages 3-4, paragraphs

[0055]-[0060]);

in response to determining to check the status for the certificate, determining whether to

check the status for the certificate in real time (Figure 7 [step S4], page 4, paragraphs [0058]-

[0061]); and

in response to determining to check the status for the certificate in real time, retrieving a

new real time status for the certificate (Figure 7 [step S4], page 4, paragraphs [0058]-[0061]).

25.   Regarding claim 43, Patterson teaches exporting the certificate if the new real time status

indicates the certificate is valid (Figure 7 [steps S1, S2], 8a [step S10], 8b [steps s11, s12], pages

3-4, paragraphs [0055]-[0060]).

26.   Regarding claim 45, Patterson teaches in response to determining to not check the status

for the certificate in real time, determining whether the check time falls within a time period,

wherein the time period begins at the time the real time status was received and extends for the

validation interval (page 4, paragraphs [0058]-[0061]).

27.   With regards to claim 46, Patterson teaches exporting the certificate if the check time

falls within the time period (pages 3-4, paragraphs [0055]-[0060]).

28.   Regarding claims 48 and 49, Patterson teaches wherein determining whether to check a

status for the certificate comprises querying a parameter field in an Identity System (Figure 3

[block 64], paragraph [0042]).

Claim Rejections - 35 USC § 103

29.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

30.   Claims 7, 10, 26, 44, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Patterson in view of U.S. Patent Application Publication No. 2003/0110376 to Wiener et

al., hereinafter Wiener.

31.   Concerning claims 7, 26, and 47, Patterson does not teach issuing an error message, if

said check time does not fall within said time period.

32.   Wiener discloses issuing an error message, if said check time does not fall within said

time period (page 4, paragraph [0030]).

33.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to issue an error message, since Wiener discloses at page 4, paragraph [0030] that such

a modification would alert a client that the certificate has expired and therefore needs to be

updated.

34.   Concerning claims 10 and 44, Patterson does not teach issuing an error message, if said

new real time status indicates said certificate is not valid.

35.   Wiener discloses issuing an error message said new real time status indicates said

certificate is not valid (page 4, paragraph [0030]).

36.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to issue an error message, since Wiener discloses at page 4, paragraph [0030] that such

a modification would alert a client that the certificate has expired and therefore needs to be updated.

Conclusion

37.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

38.   A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

39.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.
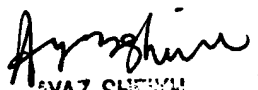
40.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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